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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/629,503	07/29/2003	David M. Mitteer	GRA01 P-418	6730
277	7590	09/22/2006	EXAMINER KRAUSE, JUSTIN MITCHELL	
PRICE HENEVELD COOPER DEWITT & LITTON, LLP 695 KENMOOR, S.E. P O BOX 2567 GRAND RAPIDS, MI 49501			ART UNIT 3682	PAPER NUMBER

DATE MAILED: 09/22/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

10/629,503

**Applicant(s)**

MITTEER, DAVID M.

**Examiner**

Justin Krause

**Art Unit**

3682

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 07 July 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) 16-23 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 July 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. <u>  \  </u> .                             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____.   | 6) <input type="checkbox"/> Other: _____.                         |

**DETAILED ACTION**

***Election/Restrictions***

1. Applicant's election with traverse of figures 2-7, readable on claims 1-15 in the reply filed on July 7, 2006 is acknowledged. The traversal is on the ground(s) that it would not be a serious burden to search all of the disclosed embodiments. This is not found persuasive because the examiner finds it would be a serious burden to conduct a search for each individual embodiments.
2. With regard to applicant's argument of the election being improper because the species are not mutually exclusive, the examiner agrees with applicant's supporting paragraph 0023, however the Examiner finds that a restriction between the knob-mounted damper and the lever-mounted damper is proper for the reasons given below:
3. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 10-15, drawn to a knob mounted damper, classified in class 74, subclass 473.11.
  - II. Claims 16-23, drawn to a lever mounted damper, classified in class 74, subclass 473.23.

The inventions are distinct, each from the other because of the following reasons:

4. Inventions I and II are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct if they do not overlap in scope and are not obvious variants, and if it is shown that at least one subcombination

is separately usable. In the instant case, subcombination I has separate utility such as in a shift lever that does not use a lever mounted damper. See MPEP § 806.05(d).

5. The examiner has required restriction between subcombinations usable together. Where applicant elects a subcombination and claims thereto are subsequently found allowable, any claim(s) depending from or otherwise requiring all the limitations of the allowable subcombination will be examined for patentability in accordance with 37 CFR 1.104. See MPEP § 821.04(a). Applicant is advised that if any claim presented in a continuation or divisional application is anticipated by, or includes all the limitations of, a claim that is allowable in the present application, such claim may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application. Because these inventions are independent or distinct for the reasons given above and there would be a serious burden on the examiner if restriction is not required because the inventions require a different field of search (see MPEP § 808.02), restriction for examination purposes as indicated is proper.

6. This application contains claims directed to the following patentably distinct species of Invention II:

Species 1: Figure 9

Species 2: Figure 10

Species 3: Figure 11

The species are independent or distinct because each species discloses a materially different structure for a lever-mounted damper device.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed invention and species (if necessary) for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claims 1-5 appear to be generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which depend from or otherwise require all the limitations of an allowable generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Applicant is advised that the reply to this requirement to be complete must include (i) an election of a species or invention to be examined even though the requirement be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected invention.

The election of an invention or species may be made with or without traverse. To reserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse.

Should applicant traverse on the ground that the inventions or species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the inventions or species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C.103(a) of the other invention.

7. Applicant's election of Figures 2-7 and claims 1-15 encompasses the knob-mounted damper of Invention I, and this election is acknowledged by the examiner. Claims 16-23 are hereby withdrawn as being drawn to a nonelected invention, claims 1-15 are pending for examination.

### ***Drawings***

8. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the "plunger", the first end portion, the second end portion and the spaced apart extensions must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

***Claim Rejections - 35 USC § 112***

9. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

10. Claims 6-15 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art

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to which it pertains, or with which it is most nearly connected, to make and/or use the invention. It is not understood what the plunger is or how the first and second end portions or extensions are arranged. This element appears critical to the function of the device and it is not described within the device in a way that would enable one of ordinary skill in the art to make and use the device.

With regard to claims 10-15, it appears to the Examiner that the "plunger" is the "extension" (element 20 in the drawings), it is not clear if this is the case, but for the purpose of examining the claims as best understood, Examiner makes this assumption. Specifically regarding claim 13, the claim language is inconsistent with the device disclosed in the drawings. Claim 13 recites that the plunger is disposed in the second cavity, which is the larger of the two claimed cavities, and from viewing for example, figures 6 and 7, it is clearly shown that the plunger is disposed in the smaller, first cavity.

11. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

12. Claim 15 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

"the second cavity defines an axis" is unclear because the second cavity is a three dimensional space capable of defining an infinite number of axes.



***Claim Rejections - 35 USC § 103***

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

14. Claims 1-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Muramatsu et al. (US Patent 4,919,242) in view of Hiramoto et al (US Patent 5,697,477).

Muramatsu discloses a shift mechanism comprising:

- a base (6)
- a shift gate having a plurality of notches (7)
- a shift lever (1) mounted to the base
- a pawl (5) configured to move between an engaged and a disengaged position
- a button on the shift lever (4) operatively connected to the pawl

Muramatsu does not disclose a pneumatic mechanism providing a first resistance against movement of the pawl in a first direction and a second resistance against movement of a pawl in a second direction, the second resistance being greater than the first. Muramatsu does however disclose a spring, which provides equal resistance in both directions.

Hiramoto teaches a pneumatic mechanism providing a first resistance in a first direction (retraction), and a different, second resistance in a second direction

(extension), the second resistance being greater than the first resistance (col 1, lines 55-63) for the purpose of obtaining satisfactory damping by coping with a change in the load by changing the damping force (col 2, lines 3-5).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate a pneumatic mechanism as taught by Hiramoto into the device of Muramatsu the motivation would have been to obtain satisfactory damping by coping with a change in the load by changing the damping force.

Regarding claim 2, Muramatsu discloses a linkage (2) disposed in the shift lever, coupled to the pawl.

Regarding claim 3, the pawl is biased into the engaged position.

Regarding claim 4, the shift lever includes a knob (3) the button being positioned on the knob, the pneumatic mechanism includes a passageway (Hiramoto, 52) through which fluid passes, a moveable member (Hiramoto, 42) that selectively restricts the passageway depending upon the direction of movement of the button.

Regarding claim 5, the movable member is a resilient ring, the pneumatic mechanism includes an annular groove (Hiramoto, 40), the resilient ring disposed in the annular groove.

Regarding claim 6, the pneumatic mechanism includes a cylindrical chamber in the knob and a plunger (Hiramoto, 12), at least a first end portion of which is slidably disposed in the cylindrical chamber (Hiramoto, 46), the annular groove located adjacent the first end portion of the plunger.

Regarding claim 7, the plunger defines an axis along which the plunger moves, the chamber defines a chamber sidewall, the annular groove defines a base wall and opposing sidewalls (see fig 5), the resilient ring frictionally engaging the base wall of the groove and the chamber sidewall.

Regarding claim 8, the plunger includes a slot (52) extending axially from the base wall towards a second end portion to form the passageway.

Regarding claim 9, the resilient ring is an o-ring.

15. Claims 10-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Osborn et al (US Patent 5,494,141) in view of Hiramoto (US Patent 5,697,477).

Osborn discloses a shift mechanism comprising:

- a base (9)
- a shift lever (10) movably mounted to the base
- a shift knob (13) mounted to the shift lever, the shift knob having a cavity (the open area within the knob, see figure 2) defining a sidewall;

Osborn does not disclose a plunger having a first end portion movably disposed in the cavity, the first end portion including an annular groove defining a base, the first end portion having a passageway extending from the annular groove away from the first end portion;

and a resilient ring in the annular groove, the resilient ring having an outer peripheral edge sealingly engaging the sidewall, and an inner edge engaging the base

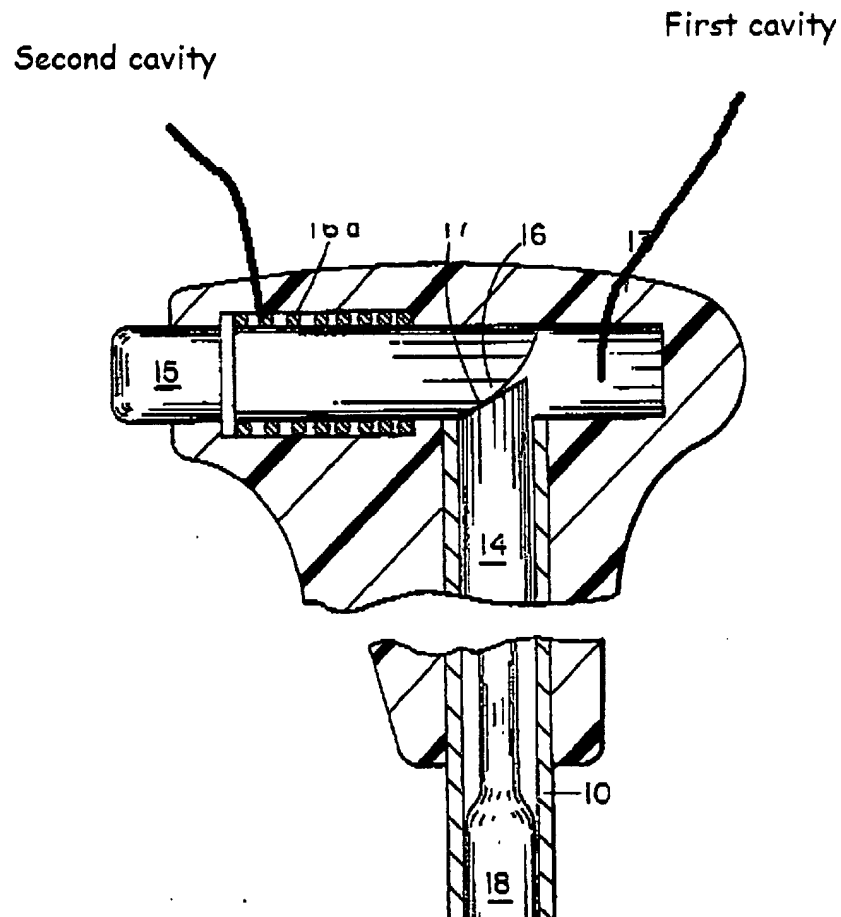
wall of the annular groove, the resilient ring configured to shift within the annular groove to close off the passageway upon movement of the plunger, but Osborn does teach a plunger, as broadly interpreted (16) which has a first end movably disposed in the cavity.

Hiramoto teaches a plunger (12) having a first end portion (see figure 5, the left side of the drawing is considered the "first end") movably disposed in the cavity, the first end portion including an annular groove (40) defining a base wall, the first end portion having a passageway (52) extending from the annular groove away from the first end portion; and a resilient ring (42) in the annular groove, the resilient ring having an outer peripheral edge sealingly engaging the sidewall, and an inner edge engaging the base wall of the annular groove for the purpose of obtaining satisfactory damping by coping with a change in the load by changing the damping force (col 2, lines 3-5).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate a plunger as taught by Hiramoto into the device of Osborn, the motivation would have been to obtain satisfactory damping by coping with a change in the load by changing the damping force.

Regarding claim 13, the cavity comprises a first cavity having a cylindrical shape defining a first diameter, the knob defining a second cylindrical cavity coaxial with the first cavity and defining a second diameter larger than the first diameter; the plunger including a second cylindrical end portion (in Hiramoto, figure 5, the right side is

considered the "second end portion") slidably disposed in the second cavity. (see figure below)



Regarding claim 14, the plunger includes a pair of spaced apart extensions extending generally parallel to the first end portion having an outer cylindrical surface portions contiguous with the second end portion, wherein the first end portion is disposed between the extensions.

Regarding claim 15, the pawl release mechanism includes a shift lever (10) connected to the shift knob and an axially movable link (18) mounted in the shift lever, the second cavity defines an axis,

The second cylindrical end portion of the plunger includes a wedge surface (see Osborn fig 2) disposed non-orthogonal relative to the axis, configured to push the link axially along the shift lever.


### ***Conclusion***

16. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Justin Krause whose telephone number is 571-272-3012. The examiner can normally be reached on Monday - Friday, 7:30-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Ridley can be reached on 571-272-6917. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



RICHARD RIDLEY  
SUPERVISORY PATENT EXAMINER